

REMARKS

I. Introduction

Applicants express appreciation for Examiner Goff's courtesy and professionalism in conducting a personal interview on December 16, 2004. Applicants also would like to thank Examiner Goff for the indication of allowance of claims 20, 23 and 37. In response to the Office Action dated September 27, 2004, Applicants have canceled claim 36, without prejudice or disclaimer. Thus, the pending rejection to claim 36 is moot in view of the cancellation thereof. Also, Applicants have amended claims 1, 25, 26, 28, 32 and 38 so as to address the pending rejection under 35 U.S.C. § 112, first paragraph and second paragraph, and to further clarify the claimed subject matter. Support for these amendments can be found, for example, in Figs. 1 and 11, and their corresponding sections of the specification. No new matter has been added.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

II. The Rejection Of Claims 1-13, 16-19, 24, 29, 30, 32-35 and 38 Under 35 U.S.C. § 112, First Paragraph

Claims 1-13, 16-19, 24, 29, 30, 32-35 and 38 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserts that there is no disclosure of either the upper rigid body or lower rigid body having a movable center portion. However, contrary to the conclusion set forth in the pending Office Action, as shown in Figs. 10 and 11 of Applicants drawings, the center portion of the second pressing force application member 33 is moved downward, while the center portion of the first pressing force application member 30 is moved upward to be pressed onto the elastic frame 36 provided on the

second pressing force application member 33, such that the first laminate 13 is enclosed by the space surrounded by the first pressing force application member 30 and second pressing force application member 33. Thus, it is respectfully submitted that the specification provides sufficient written support for the rejected claims. However, in an effort to advance prosecution, the foregoing claim language has been deleted from the pending claims. Thus, these rejections under 35 U.S.C. § 112, first paragraph, are moot.

III. The Rejection Of Claims 26 and 28 Under 35 U.S.C. § 112, Second Paragraph

Claims 26 and 28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner asserts that the claim element “said elastic body” recited by claims 26 and 28 lack antecedent basis. It is respectfully submitted that the foregoing amendments to claims 26 and 28 address and overcome the pending rejections under 35 U.S.C. § 112, second paragraph.

IV. The Rejection Of Claims 1-11, 13, 16-19, 24-30, 32-35 and 38 Under 35 U.S.C. § 103

Claims 1-11, 13, 16-19, 24-30, 32-36 and 38 are rejected under 35 U.S.C. § 102 as being unpatentable over USP No. 5,573,622 to Hass in view of USP No. 5,268,415 to Pieterse and GB 2274810 to Kodera, and optionally in view of USP No. 5,478,420 to Gauci. Applicants respectfully traverse this rejection for at least the following reasons.

Claims 1, 25 and 32

Claims 1, 25 and 32, as amended, recite in-part a manufacturing method of laminates, wherein the second elastic body covers a lower surface and portion of the outside perimeter of the first laminate.

In accordance with one exemplary embodiment of the present invention, by applying a pressing force to the first laminate 13 uniformly in all direction, the outer surfaces of the first laminate 13 are covered by the elastic bodies 32/35 (see, e.g., page 18, lines 9-12 of the specification). As a result, the present invention advantageously produces a laminate having minimal structural defects.

Turning to the cited prior art, at a minimum, Hass is silent regarding to providing a resilient complaint material which covers the lower surface and portion of the outside perimeter of the multilayer stack 10. Indeed, as acknowledged by the Examiner during the personal interview (see, Interview Summary) and as shown in Fig. 4, the resilient complaint material 56 of Hass only covers the lower surface of the multilayer stack 10, and does not cover the lower surface *and* portion of the outside perimeter of the multilayer stack 10. Moreover, Pieterse, Kodera and Gauci appear silent with regard to the aforementioned feature. Thus, Pieterse, Kodera and Gauci also do not cure this defect of Hass.

Thus, Hass, Pieterse, Kodera and Gauci, taken alone or in combination, do not disclose or suggest the claim elements recited by amended claims 1, 25 and 32.

Claim 27

Claim 27 recites in-part a manufacturing method of laminates comprising a first step of preparing a first laminate, a second step of preparing a second laminate, a third step of obtaining a third laminate by having said first laminate sandwiched between a first elastic body and a steel plate, and obtaining a fourth laminate by having said second laminate sandwiched between a second elastic body and said steel plate.

In accordance with one exemplary embodiment of the present invention, a pair of laminates are disposed on both surfaces of the stainless steel plate 40 in such a way as opposing to each other with the stainless steel plate 40 sandwiched therebetween, such that the stainless steel plate 40 with the first laminate 13 disposed on both surfaces thereof is fixed between the first pressing force application member 30 and the second pressing force application member 33. As a result, an uniform pressing force is applied to the first laminate 13 (see, e.g., page 19, line 26 to page 20, line 26 of the specification).

In contrast, Hass discloses forming an optional template on top of the multilayer stack 10 (see, col. 6, lines 9-11). As such, it would appear that the multilayer stack 10 is sandwiched between the optional template and the resilient compliant material 56, rather than between the optional template and the resilient material 36'.

Furthermore, during the interview, the Examiner argues that Hass discloses forming multiple stacks with cavities, and placing an optional template on top of *each* stack, such that the top multilayer stack is positioned between the resilient compliant material 36' and an optional template disposed on top of the bottom multilayer stack, where the bottom multilayer stack is placed between the optional template and a compliant resilient material formed underneath the bottom multilayer stack.

However, noting Hass specifically discloses utilizing the optional template for controlling the distribution of stress during the bonding operation so as to ensure that the top surface of the layer 16 possesses an adequate surface finish and flatness (col. 6, lines 11-14), and that a flattened laminate can also be obtained by using a pair of rigid upper platen and lower platen (see, col. 9, lines 9-10), it is respectfully submitted that such an optional template is not necessary in forming the alleged multiple stacks, because surface flatness is readily obtained by the upper platen and the lower platen. As such, the Examiner's reconstruction of the claimed structure using such an optional template is improper.

Even assuming *arguendo* that the Examiner's conclusion is proper, the disclosure of Hass does not disclose or suggest placing an optional template **on each and every** multilayer stack when multiple multilayer stacks are formed. Indeed, Hass only discloses placing an optional template on top of the multilayer stack 10, but does not provide any support for the Examiner's assertion that **more than one** optional template can be applied in the alleged multi-stacked structure. Rather, it appears that the Examiner includes the knowledge of the manufacturing method of laminates gleaned from Applicants' disclosure to reconstruct the claimed subject matter. Thus, it is respectfully submitted that Hass merely states placing an optional template on the multilayer stack 10, but does not discuss or provide any motivation for placing a **second** optional template on top of the bottom stack in the manner alleged by the Examiner. Also, Pieterse, Kodera and Gauci, taken alone or in combination, are silent with regard to the aforementioned feature, and also do not cure this defect of Hass.

For at least these reasons, it is respectfully submitted that Hass, Pieterse, Kodera and Gauci, taken alone or in combination, do not disclose or suggest the claim elements recited by claim 27.

Claim 38

Claim 38 recites in-part a manufacturing method of laminates, wherein a first non-adhesive film is formed on the upper surface of the first laminate and a second non-adhesive film is formed on the lower surface of the first laminate.

However, Hass is silent with regard to providing a second release layer. Indeed, it appears Hass discloses only a single release layer 52 positioned on top of the multilayer structure 10, and does not disclose or suggest utilizing more than one release layer in the manner suggested by the Examiner. Pieterse, Kodera and Gauci appear silent with regard to the aforementioned feature. Thus, Pieterse, Kodera and Gauci also do not cure this defect of Hass.

Thus, Hass, Pieterse, Kodera and Gauci, taken alone or in combination, do not disclose or suggest the claim elements recited by claim 38.

Accordingly, as each and every limitation must be either disclosed or suggested by the cited prior art in order to establish a *prima facie* case of obviousness (see, M.P.E.P. § 2143.03), and Hass, Pieterse, Kodera and Gauci, taken alone or in combination, fail to do so, it is respectfully submitted that claims 1, 25, 27, 32 and 38 are patentable over the prior art.

Additionally, it does not appear that any of the cited prior art discloses or suggest the claim elements recited by new claim 39-42. Thus, it is respectfully requested that claims 39-42 be allowed for reasons similar to those discussed above with respect to claims 1, 25, 27, 32 and 38.

V. All Dependent Claims Are Allowable Because The Independent Claims From Which They Depend Are Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are

contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as independent claims 1, 25, 27, 32 and 38 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance.

VI. Conclusion

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Michael E. Fogarty
Registration No. 36,139

Please recognize our Customer No. 20277
as our correspondence address.

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 MEF/AHC
Facsimile: 202.756.8087
Date: January 18, 2005